

Docket No.: 103864,134-US1  
Serial No. 10/634,990

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REMARKS

In the Office Action, the Examiner noted that Claims 34-41, 43-61, 68 and 69 are pending in the application, and that Claim 69 is withdrawn from consideration. In addition, the Examiner noted that Claims 37, 41, 43-45 and 49-52 are allowed over the prior art of record. Applicant graciously acknowledges the Examiner's indication of allowable subject matter.

By this Amendment, Claims 34, 56, 59 and 68 have been amended, and Claim 69 has been cancelled without prejudice or disclaimer. In addition, new claims 70-74 have been added. Thus, Claims 34-41, 43-61, 68 and 70-74 are presented for examination. Applicant respectfully submits that no new matter has been introduced into the present application, and that the amendments to the claims are supported by the originally filed specification and drawings.

The Examiner's rejections are traversed below.

Election/Restriction

The Examiner noted that Claims 34-41, 43-61 and 68-69 recite subject matter which are separate inventions. The Examiner states that claim 69 is a method that is a separate invention

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from the system claims of Claims 34-41, 43-61 and 68. Claim 69 has been withdrawn from consideration. Applicant has cancelled claim 69 in response to the election requirement.

Rejection Under 35 USC Section 103

Claims 34-36, 38-40, 42 46-48, 53-61 and 68 are rejected based on one or more of the following prior art references: Hoffmann U.S. Patent 4,181,555; Fattal et al. U.S. Patent 4,927,486; Voltmer et al. U.S. Patent 4,502,910 combined with Vijuk U.S. Patent 6,273,411.

Applicant respectfully traverses this rejection.

Specifically, U.S. Patent 4,181,555 entitled "Labeling apparatus and method for continuously severing labels from continuous label stock and applying the severed labels to containers," relates to a continuous labeling apparatus and method for applying labels to containers. A continuous label stock which is pre-printed is fed between an anvil roller and a rotary die, and labels are severed, scrap material is rewound, and each severed label is picked up by a rotary vacuum drum and is supplied to a label applying station where the drum and a container feed come together. Thus, this prior art reference does not at all relate to the present invention that prepares **customer specific orders**. In addition, this prior art reference does not at all **reduce the label size**, which is one of the optional significant benefits of the present invention.

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U.S. Patent 4,502,910 entitled "Literature applying mechanism" includes a label application device for packaging equipment, and uses adhesive covered tape from which labels are peeled by bending over peel bar edge. The system dispenses literature carried by a conveyor, and includes a tape for the application of adhesive to literature, and a device for the separation of the literature from the tape to permit the securing of the literature, adhesively, to the containers.

A drive mechanism is provided for advancing the tape through successive increments of distance, each incremental distance being equal to the size of one piece of literature. A hopper dispenses the literature to the tape, one piece at a time. The literature separation device includes a bar having an edge about which the tape is bent to free the literature from the tape as the tape advances around the edge. The adhesive is retained by the literature during the separation from the tape so as to permit the adhesive attachment of the pieces of literature to the containers. Thus, this prior art reference also does not at all relate to the present invention that prepares customer specific orders. In addition, this prior art reference does not at all reduce the label size, which again is one of the significant benefits of the present invention.

U.S. Patent 6,273,411 entitled "Booklet forming method and apparatus" relates to a method of forming a booklet from a single sheet of paper by depositing an adhesive along a linear path on a single sheet of paper and folding the sheet by making folds parallel to first direction, to form interconnected panels. The lateral edges of the panels are cut off so that the panels are no longer interconnected. A fold is made along a line coincident with the linear path to form the booklet. The booklet may be further folded with close folds to obtain a compact outset.

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Accordingly, this prior art reference does not at all discuss or relate to customer specific labels. In addition, there is no motivation or suggestion to utilize this prior art references for the labeling of patient specific pharmaceutical and/or prescription orders.

U.S. Patent 4,927,486, entitled "System for applying labels to pallets movable along a conveyor line," incorporates a sensor that senses the presence of a pallet at a label applying station on the conveyor line and a label printer/dispenser produces labels for applying to the pallet. A robot arm moves a label receiver/applier between a first position, adjacent the label printer/dispenser for receiving a label, a second position adjacent the label applying station for applying a label to the pallet, and a third position whereat a label reader, also mounted on the robot arm, reads the label. A processor controls the robot arm, the label reader and the label printer and dispenser and compares the text of the read label to determine if it is correct, and it also determines whether the label is correctly positioned.

The currently amended claims have been amended in accordance with the Examiner's indication of allowable subject matter, in its entirety or in part. Accordingly, these claims recite subject matter that is not considered to be a narrowing description, but rather recite subject matter that Applicant considers to be commensurate with the scope of protection of the present invention, as well as any equivalents that are substantially similar to the presently claimed invention.

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The Examiner states at page 3 of the Office Action, that tool 153/155 folds the label by rolling it around and between a set of rollers in Vijuk, U.S. Patent 6,273,411. The Examiner further states on page 4 of the Office Action that tool 152 of Vijuk is provided such that the label is "capable" of being maintained in a reduced orientation when folded by tool 153/155. In addition, the Examiner states that Vijuk is "capable of labeling bottles and packages," (emphasis added) and that Vijuk is "capable" of the function of the label being unrolled and resetured in the rolled shape by a user without damage. Applicant respectfully submits that the Examiner has misapplied the test for obviousness. Specifically, the Board of Patent Appeals and Interferences has clearly stated that the fact the prior art is "capable" of performing or providing functions of an invention, is not sufficient for a holding of obviousness:

The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art." The examiner then indicates that because the various aspects of the claimed process were individually known in the art, the modifications of the electrophoretic process of Levengood by exposing Levengood's plant materials to cell-associated materials in order to "graft" or otherwise incorporate the cell associated material into the plants was "well within the ordinary skill of the art at the time the claimed invention was made."

We reverse the rejection because the examiner has used the wrong standard of obviousness. . . . At best, the examiner's comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant's invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. . . . *That which is within the capabilities of one skilled in the art is not synonymous with obviousness.* . . . That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. . . .

Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing

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evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.

*Ex parte Levingood*, 28 USPQ2d 1300, 1301–02 (B.P.A.I. 1993).

In addition, the Examiner states at Page 4, “it is conventional in the art to provide labeling systems with devices capable of applying a labeling adhesive.” In addition, the Examiner states at Page 5, “controllers are conventional in the labeling art to ensure a more accurate label placement.” Applicant respectfully disagrees that these features are well known with respect to the claimed combination of a system for labeling of a container including a medication. Accordingly, Applicant requests the Examiner to provide a prior art reference describing this well known feature in the context of the present invention, or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicant respectfully requests the Examiner to withdraw the rejection.

In addition, Applicant respectfully submits that the combination of features in the rejected claims is patentably distinguishable over the prior art, when each claim is considered a whole, for each independent combination recited therein.

Without conceding that the prior art describes any of the features of the presently claimed invention, Claim 34 recites, in combination, a “system for labeling of a container including a medication, comprising at least one of a bottle and a package, with a label providing information regarding the medication to a consumer thereof.” Claim 34 also recites that the system comprises

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"a label reducing tool to reduce the label in a reduced orientation while maintaining barcode indicia visible for subsequent scanning, and a label securing adhesive application device, which applies a label securing adhesive to the label such that the label is capable of being maintained in the reduced orientation." Claim 34 also recites, in combination, "a surface securing adhesive application device, which applies a surface securing adhesive to the reduced label such that the reduced label is capable of being attached to the container; a label shuttle block, wherein the label shuttle block conveys the reduced label from the label reducing tool to the surface securing adhesive application device; and a barcode reader, wherein the barcode reader scans a the barcode printed on the reduced label to facilitate correct matching of the reduced label to the container."

Accordingly, Applicant respectfully submits that the combination of limitations recited in independent claim 34 patentably distinguishes over the prior art. Withdrawal of this rejection is respectfully requested.

In addition, the remaining dependent and independent claims are also asserted to be patentable over the prior art, for each of the independent combination of limitations recited therein.

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New Claims 70-74 have been added in accordance with the Examiner's indication of allowable subject matter and/or arguments presented herein. Accordingly, these claims also recite subject matter that is not considered to be a narrowing description, but rather recite subject matter that Applicant considers to be commensurate with the scope of protection of the present invention, as well as any equivalents that are substantially similar to the presently claimed invention.

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CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims. Moreover, Applicant reserves the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

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Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, i.e., all equivalents that are substantially the same as the presently claimed invention.

Further, Applicant hereby retracts any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicant specifically retracts statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

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For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

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PATENTAUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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